


| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 0879-0345P | |
|--|--|---|------------------------|
| | | Application Number 09/917,729-Conf. #1253 | Filed July 31, 2001 |
| First Named Inventor Masahiro TERADA | | | |
| Art Unit 2143 | | Examiner K. H. Shin | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 39,491</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34.</p> <p> Signature Michael R. Cammarata Typed or printed name (703) 205-8000 Telephone number October 10, 2008 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of 1 forms are submitted.</p> | | | |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Masahiro TERADA

Application No.: 09/917,729

Confirmation No.: 1253

Filed: July 31, 2001

Art Unit: 2143

For: COMMUNICATION APPARATUS, SERVER,
SERVICE CENTER, AND SERVICE METHOD

Examiner: K. H. Shin

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed concurrently with a Notice of Appeal.

The review is being requested for the reasons set forth on the attached five (5) Sheets.

As detailed below, the Examiner has made clear errors in facts, and has failed to establish a *prima facie* prior art rejection due to clearly missing teachings from the applied art.

The Examiner Has Committed Clear Error By Ignoring Parts Of The Written Description And Figures That Clearly Describe The Claimed Invention So As To Satisfy § 112, ¶ 1, And Has Failed To Establish *Prima Facie* Lack Of Enablement.

The Examiner has made a clear error in requiring that literal support for all of the claim terms in claims 1-3, 5, 8-10, 16-20, 26, 27-41, 43, 47-49, 51, and 52 be provided. In particular, the Examiner maintains that the Specification does not provide support for the terms “adapting device”, “first recording device”, “second recording device”, and “portable camera.”

It is well recognized that in order to establish a *prima facie* case of lack of written description, the Examiner must show that the application does not reasonably describe or convey the concepts to one having ordinary skill in the art at the time of filing the patent application of the claimed invention. Further, it is well established that adequate description under 35 U.S.C. § 112, ¶ 1, does not require literal support for the claimed invention. Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that the applicant had possession of the concept of what is claimed. *Ex parte Parks*, 30 USPQ.2d 1234 (B.P.A.I. 1994). “The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” MPEP § 2163.02.

Applicants respectfully submit that, without using the literal terms “an adapting device ...” and “adapting a service menu ...” as recited respectively in **claims 1 and 20**, the specification clearly discloses that a service menu may be constructed differently (i.e., adapted) depending on data obtained (e.g., identification data of a camera). *See* Fig. 7; Specification page 8, line 25 to page 9, line 8; and Specification page 13, line 27 to page 14, line 18. That is, the service menu presented to a user is changed depending on at least the identification information. Clearly, the specification supports a device and method for adapting a service menu.

Moreover, the terms “first recording device” and “second recording device,” as recited by **claims 28-37**, are permissible based on the present specification. The specification and original claims disclose individual recording devices each of which records a different set of information. The terms “first” and “second,” amended to claims 28-37 in the Amendment dated February 4, 2008, were introduced merely to improve clarity and to remove possible antecedent issues, since multiple recording devices were similarly claimed. For instance, as originally presented, claim

28 recited “a recording device that records the identification information and utility information related to services used by the user”. In contrast, claim 29 which depends from claim 28 formerly recited “a recording device that records the identification information and user information on the user”. The recording devices, both included in the same server, clearly record different types of information. As evidenced above, the literal terms “first recording device” and “second recording device” are not required by any law or rule to be recited in the specification “using the same terms or *in haec verba*” in order to be supported by the specification. The specification provides voluminous support for the multiple recording devices. *See, e.g.*, Specification pages 2, 4.

The term “portable camera,” as recited by **claims 1-3, 5, 8-10, 16-20, 26, 28-41, 43, 47-49, 51 and 52** is also clearly disclosed in the specification. More particularly, one having ordinary skill in the art would understand the portability of the camera disclosed, having reviewed the figures and the disclosed use of a docking cradle 12 for the camera. *See, e.g.*, Specification, Figures 1, 4, and 5 (“attach/detach electronic camera”), and pages 3-4.

For these reasons, Applicants maintain that the originally filed disclosure clearly conveys the claimed concepts to one skilled in the art. As such, the Examiner has failed to provide a *prima facie* case of lack of adequate written description.

The Examiner has Failed to Establish *Prima Facie* Obviousness by Failing to Provide References that Teach or Suggest All of the Claim Elements.

Pending claims 1-15, 20-32, 38-41 and 43-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Safai* (USP 6,836,617) (hereinafter “Safai”) in view of *Noro et al.* (USP 6,646,677) (hereinafter “Noro”). Noro is alleged to disclose use of “product identification information identifying a particular portable camera registered by a user”, as variously recited by independent claims 1, 3, 5, 8, 9, 10, 20, and 32. The Office Action recognizes that Safai fails to disclose this feature. OA dated July 10, 2008, at page 7. However, Noro similarly fails to disclose said product identification information identifying a particular portable camera. Noro merely discloses “identification information for uniquely identifying the camera management device 12 or 14.” Noro, col. 8, lines 47-51 (Emphasis added). As is clear from the Noro specification, a camera management device not a portable camera, but is a device configured for

controlling a direction and zoom ratio of immobile surveillance cameras connected to the management device. *Id.*, col. 6, lines 56-64.

Moreover, the identification information of the camera management device disclosed identifies the management device address, but not the product. Examiner asserts that the camera table 82 holding "a combination of names representing the individual camera positions, and identification information for uniquely identifying the camera management device 12 or 14" equates to the claimed feature of "product identification information identifying a particular portable camera registered by a user." However, Examiner apparently confuses "camera position" information with "product identification information." Surveillance cameras directed by the management device are not disclosed by Noro to be registered by a user nor identified through product identification information received from the cameras.

Examiner also failed to recognize that neither Safai nor Noro discloses "an adapting device that adapts a service menu associated with the products identification information" or "adapting a service menu associated with the product identification information," as recited in claims 1 and 20, respectively, and supported in the specification as described above.

Nor do the Safai and Noro references disclose transmission of product identification information identifying a particular camera to a service center, as variously recited by claims 1 and 20.

Consequently, none of the applied prior-art references discloses every feature of the noted independent claims.

The Examiner Has Failed To Establish *Prima Facie* Obviousness By Failing To Provide A Reasonable Motivation to Combine The References.

Examiner asserts, as rationale to combine Safai and Noro, that the combination would be obvious "in order to optimize real-time camera control for a client having access control [i.e., a camera operation device, or personal computer]." OA page 5. However, "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01 (VI); *See also, In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Applicants submit that such real-time control of a camera's direction and zoom ratio as is disclosed by Noro, though perhaps useful for Noro's stationary surveillance

camera management, would serve to change the principle of operation of the image communication device disclosed by Safai. Safai discloses communication of stored images from a memory device to a remote server. Safai, abstract. Examiner proposes as reason to combine “in order to optimize real-time camera control for a client having access control.” However, since Safai does not disclose real-time (or any other) remote camera control, optimization of such would not be possible or logical.

Moreover, Applicants submit that it would not be obvious to one having ordinary skill in the art to add real-time control of camera direction and zoom ratio to the image-communication device disclosed by Safai since the communication of images from a camera to a server does not include instructions that control the image capture section of a camera. Moreover, transmission of images to a server arguably is a single-direction communication.

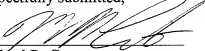
Conclusion

In summary, the Examiner has committed clear error on several grounds as detailed above. Therefore, the art rejection should be withdrawn and the case allowed.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: October 10, 2008

Respectfully submitted,

By 

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